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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/619,149	07/14/2003	Sanjeev Kumar (Mendiratta)	213-0086US	8546
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WONG CABELLO LUTSCH RUTHERFORD & BRUCCULERI, LLP 20333 SH 249, SUITE 600 HOUSTON, TX 77070			EXAMINER KOSSON, ROSANNE	
			ART UNIT 1651	PAPER NUMBER

DATE MAILED: 06/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/619,149

Applicant(s)

KUMAR (MENDIRATTA), SANJEEV

Examiner

Rosanne Kosson

Art Unit

1651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-27 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-9, drawn to a method of improving an angiogenesis-inhibitory effect of an anti-angiogenic serpin, classified in class 435, subclass 219.
- II. Claims 10-16, drawn to an anti-angiogenic serpin covalently linked to a polymer, classified in class 435, subclass 180.
- III. Claims 17-27, drawn to a method of inhibiting a disease having a pathological angiogenic component, classified in class 424, subclass 94.3.

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the process may also be used to make an immobilized serpin or immobilized serpin-containing preparation for purifying or modifying the serpin. Thus, restriction of these groups is proper.

Inventions II and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, serpin-containing compounds, which have a variety of uses, may be used to aid in digestion, in

blood clotting, and in functioning of the complement cascade. Further, polymer-containing compounds, such as poloxamer-containing compounds, may be used to inhibit cell-cell adhesion in vascular disorders (Ahmed et al., Thromb Haemost 86(6):1532-1539, 2001, see Abstract and pp. 1533-1536). Thus, restriction of these groups for examination purposes is proper.

Inventions I and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the invention of Group I, directed to a method of covalently linking an anti-angiogenic serpin to a polymer, and the invention of Group III, directed to a method of treating subjects having a disease with a pathological angiogenic component, clearly have different modes of operation, different functions and different effects. Because these inventions are distinct and have acquired a separate status in the art as shown by their different classifications, restriction for examination purposes as indicated is proper. Also, as the search required for one group is not required for another group, restriction for examination purposes as indicated is proper.

Additionally, this application contains claims directed to the following patentably distinct species of the claimed invention:

- (a) the anti-angiogenic serpin of claims 2, 12 and 18,
- (b) the disease of claim 21.

Should Applicant elect Group I or Group II, an anti-angiogenic serpin must be elected from claim 2 or 12, respectively. Should Applicant elect Group III, an anti-angiogenic serpin must be elected from claim 18 and a disease must be elected from claim 21.

Thus, depending on which of the above groups Applicant elects, Applicant is also required under 35 U.S.C. 121 to elect a single disclosed species of anti-angiogenic serpin and, in the election of Group III, of disease, within the elected group for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 2, 12, 18 and 21 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is/are elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, Applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should Applicant traverse on the ground that the species are not patentably distinct, Applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over

the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rosanne Kosson whose telephone number is 571-272-2923. The examiner can normally be reached on Monday-Friday, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Rosanne Kosson
Examiner
Art Unit 1651

rk
2004-06-18



FRANCISCO PRATS
PRIMARY EXAMINER